

Attorney Docket No. O/98414 US

Applicants have canceled claim 6; thus, the rejection is now moot. Applicants have added new claim 7 to claim the method within claim 6 in proper U.S. format.

Applicants respectfully request withdrawal of the 35 U.S.C. §112, second paragraph, rejection.

Issue Under 35 U.S.C. §102(b)

Claims 1-6 stand rejected under 35 U.S.C. §102(b) as being anticipated Lobaccaro et al. (J. Med. Chem., 1997, 40, 2217-2227). Applicants submit that patentable distinctions exist between the present invention and the cited prior art.

Distinctions Between the Present Invention and Lobaccaro et al.

Lobaccaro et al. discloses that the  $11\beta$  position of the steroid in compounds 5a-b is substituted with ethyl, butyl or decyl chains. The Examiner asserts that compounds 5a-b in scheme 1 of Lobaccaro et al. discloses each element of the present invention.

Lobaccaro et al. fails to disclose a steroid compound of formula I, wherein  $R^{11}$  is a hydrocarbon group which may be linear, or branched comprising one singular linear chain having a length of from 5 to 9 carbon atoms as the longest chain.

Clearly, Lobaccaro et al. only discloses hydrocarbon chain lengths of 2, 4 and 10.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Thus, Lobaccaro et al. fails to anticipate the present invention because the hydrocarbon group of the present invention in the 11 position is not an ethyl, butyl, or decyl chain.

Applicants respectfully request withdrawal of the 35 U.S.C. §102(b) rejection.

Issue Under 35 U.S.C. §102(b)

Claims 1-6 stand rejected under 35 U.S.C. §102(b) as being anticipated Napolitano et al. (J. Med. Chem., 1995, 38, 2774-2779). Applicants submit that patentable distinctions exist between the present invention and the cited prior art.

Distinctions Between the Present Invention and Napolitano et al.

Napolitano et al. discloses that the 11 $\beta$  position of the steroid is substituted or unsubstituted short chain alkyl groups (less than five carbon atoms). The Examiner asserts that

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compound 21 in Table 1 on page 2776 of Napolitano et al. discloses each element of the present invention.

Napolitano et al. fails to disclose a steroid compound of formula I, wherein R<sup>11</sup> is a hydrocarbon group which may be linear, or branched comprising one singular linear chain having a length of from 5 to 9 carbon atoms as the longest chain. Clearly, Napolitano et al. only discloses short chain hydrocarbons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Thus, Napolitano et al. fails to anticipate the present invention because the hydrocarbon group of the present invention in the 11 position is not short chain hydrocarbon as defined in Napolitano et al.

Applicants respectfully request withdrawal of the 35 U.S.C. §102(b) rejection.

Issue Under 35 U.S.C. §102(b)

Claims 1-4 stand rejected under 35 U.S.C. §102(b) as being anticipated Baran '301 (USP 3,755,301). Applicants respectfully submit that patentable distinctions exist between the cited prior art and the present invention.

Distinctions Between the Present Invention and Baran '301

In column 1, lines 2-21, Baran '301 generally discusses manufacturing an  $11\beta$ -alkyl steroid, wherein the 11 position is a lower alkyl radical. Baran '301 typifies a lower alkyl as being methyl, ethyl, propyl, butyl, pentyl, hexyl, heptyl, and the corresponding branched-chain isomers.

Baran '301 expressly discloses, in examples 7-11, steroids with an allyl or propyl group at the 11 position. Therefore, Baran '301 fails to expressly disclose a steroid compound of formula I, wherein  $R^{11}$  is a hydrocarbon group which may be linear, or branched comprising one singular linear chain having a length of from 5 to 9 carbon atoms as the longest chain.

The boilerplate language found in column 1, lines 2-21 fails to have sufficient backing in the examples to provide the basis for an anticipation rejection. The range of hydrocarbons disclosed in Baran '301 fails to have "sufficient specificity" yx to support the anticipation rejection, since none of the examples disclose compounds that overlap with the present invention. See MPEP 2131.03.

Applicants respectfully request withdrawal of the 35 U.S.C. §102(b) rejection.

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Conclusion

Applicants submit that every issue raised by the outstanding Office Action has been addressed and rebutted. Therefore, the present claims define patentable subject matter and are in condition for allowance.

Attached hereto is a marked-up version of the changes made to the application by this amendment.

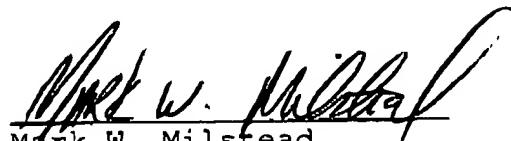
Should the Examiner believe that a conference would be helpful in advancing the prosecution of this application, he is invited to telephone Applicants' Attorney at the number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2334 for any

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additional fees required under 37 C.F.R. §§ 1.16 or 1.17;  
particularly, extension of time fees.

Respectfully submitted,



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Enclosure: Version with Markings to Show Changes Made

**Version with Markings to Show Changes Made****IN THE CLAIMS:**

Claim 6 has been canceled without disclaimer or prejudice to the subject matter contained therein.

Claim 7 has been added.